

REMARKS

The application has been amended and is believed to be in condition for allowance.

Independent claims 8-9 have been amended to recite the surface elements have both a rectangular surface area and a rectangular cross section perpendicular to the rectangular surface area. New dependent claims have been added that recite the surface elements as each of marble, natural stone, and ceramic tile elements.

Claims 8, 9, 11-14, 16 and 18 are rejected as obvious over any of STOUT 3,077,059, ARISAWA 4,804,569, YAREMCHUK 3,411,257 in view any of ALEXANDER 2,253,219, RUBY 5,323,762, RUBY 5,618,601, and RUBY 5,824,382.

STOUT was offered as disclosing brick 18 attached to support 14.

Brick is none of ceramic tile, marble, and natural stone as recited. Therefore, STOUT does not satisfy this requirement as recited at least by the new dependent claims.

YAREMCHUK was offered as disclosing bricks 12, 14, 16, 30 attached to support 20. Brick is none of ceramic tile, marble, and natural stone as recited. Therefore, YAREMCHUK does not satisfy this requirement.

Further, YAREMCHUK is not seen to disclose the flexible support, with the first, second and third surface elements adhered thereto, bendable from the planar configuration to an

overall orthogonal configuration where that the first surface section is orthogonal to the third section and the bent second surface section forms the quarter-circle arcuate surface.

It appears that the support 20 of YAREMCHUK would be first installed against a building and then the brick applied thereto. Thus, the support and bricks together would not be bendable as recited.

ARISAWA was offered as disclosing tiles 6 attached to support 7. However, as acknowledged by the Official Action (page 4, lines 16-18), the ARISAWA tiles are made of plastic materials. The Official Action urges that it would be obvious to replace plastic material with ceramics and stone materials. Even if it were obvious to make the proposed substitution in a tile product designed to be bent 90 degrees at a single line (Figure 3), there is no teaching to suggest this substitution would be obvious for a product to include a flexible support, the tile product bendable from a planar configuration to an overall orthogonal configuration where that the first surface section is orthogonal to the third section and the bent second surface section forms a quarter-circle arcuate surface

As acknowledged by the Official Action, none of these references disclose a flexible support bendable from a planar configuration to an overall orthogonal configuration where that the first surface section is orthogonal to the third section and

the bent second surface section forms a quarter-circle arcuate surface (OA page 3, first full paragraph).

The Official Action points to ARISAWA for disclosing that there is no limitation as to how the tiles are arranged on the support (column 3, lines 23-42). Even though there is no limitation as to how the tiles may be laid out, that does not mean that every possible layout of tiles is obvious.

It is not enough that the prior art could be modified so as to meet the recitations of the pending claims. The necessary modification must be motivated by the prior art itself and not by hindsight gained from the present application.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The Federal Circuit has stated that, "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), citing *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

The Official Action offers the secondary references (ALEXANDER, RUBY '762, RUBY '601, and RUBY '382) as disclosing

"rectangular surface elements that have a space or recess there between extending the width of the whole body, being glued to a flexible substrate wherein the upper edge of the elements touch when the composite is bent in the manner recited" (lines 1-4 of second paragraph of OA page 3).

ALEXANDER Figure 4 is offered as disclosing a flexible article bent into an orthogonal position with a quarter circle surface formed at the bend. But see that ALEXANDER discloses a wood veneer panel with veneer sheets 13, 14, 16, 17 on each side of the panel.

As an initial matter, ALEXANDER is non-analogous art with respect to the primary references. Again, STOUT discloses brick attached to a support, YAREMCHUK also discloses bricks attached to a support 20, and ARISAWA discloses tiles attached to a support. None of these is related to wood veneer panel. Accordingly, ALEXANDER is non-analogous art and its use in an obviousness rejection is improper.

Further, the structure of ALEXANDER is different from each of these primary references. In each primary reference, the support is on only one side and there is no support on the exposed, finished side. ALEXANDER teaches a support (veneer panel) on each side.

The teaching of ALEXANDER, if applied to the primary references, would be to use a flexible veneer panel on both sides of the core. One of skill would not modify the primary

references, as suggested by the Official Action, because a veneer panel on the exposed, finished side would defeat the purpose of the brick or tile finish product.

Thus, ALEXANDER fails to provide the requisite motivation to modify the primary references.

Similarly, the RUBY references are all non-analogous art with respect to the primary references. Each of the references relate to products distinctly different from either brick or tile. RUBY '762 is directed to a self configuring coreless structural element for furniture.

Accordingly, the RUBY references are non-analogous art and their use in an obviousness rejection is improper.

Further, the structure of RUBY references is different from each of these primary references. In each primary reference, the brick or tile is a rigid non-deformable material whose exterior surface is a finished product intended to act as an exposed finished surface.

RUBY '762 teaches tapered trapezoid rib elements where the closeness and shape of the ribs controls and determines the minimum curve radius (column 2, lines 20-29). Attention is directed to Figures 4-6 and 7a, 7b as to the use of trapezoid rib shapes to allow the curved radius. The invention has elements that have both a rectangular surface area and a rectangular cross section perpendicular to the rectangular surface area.

The teaching of RUBY '762, if applied to the primary references, the bricks/tiles would not have both a rectangular surface area and rectangular cross section.

Thus, RUBY '762 fails to provide the requisite motivation to modify the primary references.

RUBY '601 and RUBY '382 are similar.

Each discloses contoured laminated structures that have resilient, deformable elements. Neither of these references discloses subject matter related to bricks or tile.

The teachings of RUBY '601 and RUBY '382 concern controlling the delamination by providing a two layer support that, upon bending, has controlled shearability (column 3, lines 4-20). At column 5, lines 1-20 there is disclosed use of a compressed latex paper scrim to control delamination. These delamination techniques do not find application with the brick and tile products of the primary references.

Thus, RUBY '601 and RUBY '382 fail to provide the requisite motivation to modify the primary references.

In performing the required obviousness analysis, the Official Action has correctly compared the STOUT, ARISAWA, and YAREMCHUK devices to the recitations of the claimed invention and identified that none of these references disclose a flexible support endable from a planar configuration to an overall orthogonal configuration where that the first surface section is orthogonal to the third section and the bent second surface

section forms a quarter-circle arcuate surface (OA page 3, first full paragraph).

What all the references fail to teach or suggest is a ceramic/stone tile comprising a flexible support bendable from a planar configuration to an overall orthogonal configuration where there is a first surface section that is orthogonal to a third section and a bent second surface section forms a quarter-circle arcuate surface.

The primary references (ARISAWA) only teach the attachment of tile to a flexible backing, but there is no disclosure that the flexible backing will bend into an overall orthogonal configuration where there is a first surface section that is orthogonal to a third section and a bent second surface section forms a quarter-circle arcuate surface.

The secondary references do not pertain to ceramic/stone tile and are therefore non-analogous.

The present rejection appears to be an exercise in hindsight where the present disclosure is effectively being used to render the claimed invention obvious. Such an approach is not permitted.

Relevant to this point, the Federal Circuit has emphasized in July, 1998 that "[m]ost, if not all, inventions are combinations and mostly of old elements." *In re Rouffett*, 47 USPQ 2d 1453, 1457 citing to *Richdel, Inc. v. Sunspool Corp.*, 219 USPQ 8, 12 (Fed. Cir. 1983). The Federal Circuit continued by noting

that "rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blue print for piecing together elements in the prior art to defeat the patentability of the claimed invention."

Thus, the Federal Circuit requires that in order to prevent the use of such hindsight, the Official Action must "show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." (*In re Rouffett* at 1458).

The Official Action has not done this required analysis and therefore the rejection fails.

Further, the burden is not on applicants to explain why the combination is not proper, but rather on the Official Action to show that the combination is proper. "When the incentive to combine the teachings of the references is not readily apparent, it is the duty of the examiner to explain why of the reference teachings are proper." *Ex parte Skinner*, 2 USPQ2d 1788, 1790 (Bd. App. & Int'f 1986), see also *Ex parte Clapp*, 277 USPQ 972, 973 (Bd. App. & Int'f 1985) (noting that, to support obviousness, "either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line or reasoning as to why the artisan would have found the

claimed invention to have been obvious in light of the teachings of the references. . . . [S]implicity and hindsight are not proper criteria for resolving the issue of obviousness.")

Additionally, claims 11 and 16 limit the recited invention to the tile being a floor-wall skirting. The references, e.g., STOUT, YAREMCHUK, and ARISAWA give no suggestion that their products can be bent to be a floor-wall skirting. These products are not dimensioned to serve as a floor-wall skirting. See ARISAWA Figure 3 does not extend all the way to the floor and the Figure 4 shows no horizontal (floor) tile part.

Thus, as to these dependent claims, the invention as recited is not obvious.

Reconsideration and allowance of all the claims are respectfully requested.

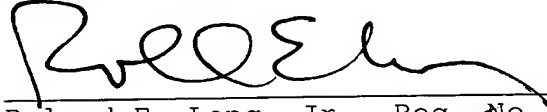
Accordingly, applicants believe that the present application is in condition for allowance. Reconsideration and allowance of the claims are therefore respectfully requested.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any

overpayment to Deposit Account No. 25-0120 for any additional
fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

YOUNG & THOMPSON



Roland E. Long, Jr., Reg. No. 41,949
745 South 23rd Street
Arlington, VA 22202
Telephone (703) 521-2297
Telefax (703) 685-0573
(703) 979-4709

REL/mjr